

Application No. 10/589,458
Amendment dated June 2, 2010
Reply to Office Action of March 2, 2010

Remarks

Applicants hereby affirm the provisional election made by James Krueger during a telephone conversation with the Examiner on February 16, 2010, to prosecute the invention of Group I, claims 1-40, without traverse. Claims 41-56 are withdrawn as being drawn to a non-elected invention. Therefore, claims 1-40 are presently under examination.

Rejections Under 35 U.S.C. § 112

Claims 1-40 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 1 is rejected as having insufficient antecedent basis for the limitation “the inlet and outlet of the brew head”. MPEP 2173.05(c) states:

If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Energizer Holdings Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006)(holding that “anode gel” provided by implication the antecedent basis for “zinc anode”); *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) (“controlled stream of fluid” provided reasonable antecedent basis for “the controlled fluid”).

Prior to the phrase “the inlet and outlet of the brew head,” the claim recites “the brew head comprising an upwardly directed inlet for supplying water to the brew head, a downwardly directed outlet for outflow of beverage produced by the machine” and contains no other intervening introduction of inlet or outlet elements relating to the brew head. Therefore, antecedent basis is indeed provided for the phrase “the inlet and outlet of the brew head” and that the scope of the claims would be reasonably ascertainable by those skilled in the art.

Claim 18 is rejected as indefinite for the use of the term “sufficient” in the phrase “said closure mechanism squeezes the insert with sufficient force for the sealing means to seal against the brew head” as recited in claim 18. The scope of the term “sufficient force” is

clearly defined by the claim itself: “for the sealing means to seal against the brew head.” In addition, the scope of the term “sufficient force” is ascertainable based on the disclosure of the specification, e.g., page 31, line 24 to page 33, line 24 of the Specification as filed.

Claim 30 is rejected as indefinite for the use of the term “generally” in the phrase “generally in an inward direction” as recited in claim 30. The term “generally” is an accepted modifier allowing for some variation from the standard, e.g., *Anchor Wall Sys. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1311 (Fed. Cir. 2003) (generally parallel would envision some amount of deviation for exactly parallel). It is clear that the term “generally in an inward direction from the inlet to the outlet” means that flow will move from the inlet to the outlet and that there may be some deviation from the flow progressing directly from the inlet to the outlet. Further, support for the phrase can be found at least at page 43, lines 3-7 and Figures 22 and 23 of the Specification as filed.

For at least the above reasons, it is respectfully submitted that claims 1-40 are not indefinite under 35 U.S.C. § 112.

Rejections Under 35 U.S.C. § 102(e)

Claims 1-7 and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Burrows et al. US 6,968,775 B2 (“Burrows”). It is respectfully submitted that claims 1-7 and 17 are not anticipated by Burrows.

With regard to claim 1, Burrows fails to disclose or suggest an insert for use in a beverage preparation machine of a type comprising a brew head, the brew head comprising a closure mechanism, wherein “on insertion of the insert into the brew head of the beverage preparation machine and movement of the closure mechanism into the closed position the sealing means is contactable with, and sealable against, the brew head to thereby close the opening of the receptacle” as recited in claim 1.

On insertion of the brew basket 12 into the brew head 28 of Burrows, movement of the rear hinged lid 38 does not cause the cap 77 to be sealable against the brew head 28 to close the

top of the brew basket 12. Instead, the cap 77 and the lid 38 function independent of each other. The hinged lid 38, which is described in Burrows only at Col. 4, lines 32-37, is depicted in the Figures as being shaped so as to not interfere with the insertion and removal of the brew basket 12. Therefore, Burrows fails to disclose or suggest that the closure of the lid 38 causes the cap 77 to be contactable with and sealable against the lid 38, or any other portion of the brew head of Burrows.

For at least the above discussed reason, Applicants assert that Burrows fails to disclose or suggest claim 1 and thereby request reconsideration and allowance of claim 1. Similarly, Applicants assert that claims 2-40, dependent from claim 1, are allowable as well.

With regard to claim 4, Burrows fails to disclose or suggest an insert wherein "the quantity of beverage ingredients loaded in use into the receptacle are contained in a container comprising filtering means" as recited in claim 4.

Instead, Burrows discloses a brew basket 12 on which mesh-like filter elements 78 are provided on portions of the side wall. The Office Action is applying the brew basket 12 against this claim as both the receptacle of the insert and as the container comprising filtering elements. However, as claimed, these are two separate and distinct elements with the container being loaded into the receptacle. The Office Action fails to identify how this is disclosed in Burrows.

Similarly with claims 5-9, the Office Action fails to identify how Burrows discloses both a receptacle and a container. With specific regard to claim 7, Burrows fails to disclose or suggest an insert "wherein the container is a filter bag" as recited in claim 7. The statement in the Office Action that Burrows discloses a filter bag stating "Fig. 7, the portion of 78 is shaped like a bag) (Office Action, page 5) is unfounded. There is no such claimed bag disclosed in Burrows.

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Rejections Under 35 U.S.C. § 103

Claims 8-13, 18-20, and 22-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows. Claims 14-16 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows, and in view of Cai US 7,032,503. Claims 21 and 26-40 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows, and in view of Halliday US 2004/0197444 A1. In view of the above discussion of Burrows as applied to claim 1, it is respectfully asserted that claims 8-16, and 18-40, dependent therefore, are allowable as well.

Conclusion

For the reasons discussed above, reconsideration and allowance of claims 1-40 are respectfully requested. The Examiner is invited to contact the undersigned attorney to expedite prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

Dated: June 2, 2010

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